

**REMARKS**

Claims 1, 3-20, 22-24, 27-39, 41, 43, and 45-54 are pending in this application.

**Drawings**

Applicants respectfully acknowledge the Examiner's approval of the proposed changes to the drawings filed February 3, 2003. It is respectfully submitted that the attached revised formal drawings comply with the requirements of provisions of 37 C.F.R. § 1.84. It is respectfully requested that the revised formal drawings be approved and made part of the record.

**Finality of the Outstanding Office Action is Improper**

Claim 1 of the present application, *inter alia*, was amended in the last response solely to present this claim in U.S. style format, as opposed to the originally presented European style format. No substantive change in claim scope of any fashion was presented to independent claim 1. Further, the Examiner's outstanding Office Action does not apply any reference previously cited by the Applicants in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. 1.97(c).

In the Examiner's first Office Action, the Examiner applied the Norwood patent as an allegedly anticipatory reference against claim 1 and the combination of Okamoto in view of Ishida against claim 1 under Section 103. Both of these rejections were withdrawn in favor of the rejections of paragraphs 5 and 7 of the outstanding Office Action. None of the newly cited documents was provided to the Patent Office by the Applicants during the operative

period and thus the new ground of rejection was not necessitated by any action on the part of the Applicant. Consequently, the finality of the present office action is improper and the Examiner should reconsider and withdraw the finality of the outstanding Office Action.

**Formal Issues**

The title of the invention has been amended as requested by the Examiner. Should the Title not be satisfactory, the Examiner is invited to suggest a preferred Title.

Applicants note the claim objection and have made the requested correction. As is apparent from Applicant's last response, the term "having" was an inadvertent typographic error to claim 1. This word has been deleted.

**Art Rejection Based on Fahraeus**

The art rejection based on Fahraeus is clearly improper and should be withdrawn. The Examiner rejects all pending claims as being allegedly anticipated by the Fahraeus Published Patent Application. It is respectfully submitted that this rejection is clearly in error for a number of reasons.

Firstly, Fahraeus, the inventor of the Published Patent Application applied as a reference is also an inventor of the present application, which in fact was filed prior to the filing of the Fahraeus application. Since Fahraeus is an inventor in both applications, the Fahraeus Published Patent Application is not the invention of another as required by Section 102(e). Thus, the Fahraeus publication may not in any event be relied on to reject the claims of the present application.

Secondly, the Examiner is in error in his assertion that the English translation was not filed in the Provisional Application 60/152,642. Attached hereto as Exhibit A to this response is a copy of the translation and a "Communication in Response to Notice to File Missing Parts of Provisional Application filed under 37 C.F.R. § 1.53(c)" filed in the U.S. Patent and Trademark Office on November 12, 1999. For the convenience of the Examiner, copies of these documents are provided.<sup>1</sup>

In any event, the filing of the translation of the first priority document, which coincidentally was filed in the name of Fahraeus, alone, confers on the present application an earliest filing date in the United States of September 7, 1999.<sup>2</sup> Thus it is apparent that the Farhaeus publication applied by the examiner may not properly be relied on as a reference against the present application under any part of Section 102. Withdrawal of this rejection is accordingly requested.

### **The Other Art Rejections**

With regard to the rejection of paragraph 6 of the outstanding Office Action, claim 46 has been cancelled, thereby overcoming the Examiner's rejection.

The Examiner has rejected claims 1-3, 9-14, 20, 22-24, 28-30, 32, 38, 41, and 43-45 as being allegedly anticipated by the Hecht patent. This rejection is respectfully traversed for the following reasons.

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<sup>1</sup> Regarding the English language translations of Provisional Applications 60/208,186 and 60/210,564, the records of the undersigned show that these documents were filed on December 14, 2000, and not on October 1, 2001 as suggested by the Examiner.

<sup>2</sup> While Applicants reserve the right to perfect priority based on Applicant's Swedish priority applications, should that later be determined to be necessary for another reason.

The Hecht patent discloses a system utilizing a glyph carpet provided on a surface to identify visual indicia. Each visual indicia or icon may be selected by a camera pen 1710 to identify the icon by its location on the glyph carpet. When selected, the icon may be used to implement the program or access the file represented thereby. In other words, the glyph lattice parameters defining the location of an icon may be used to identify the icon and cause the computer to execute the function represented thereby. While the Examiner may recognize the relevance of the Hecht patent, the Examiner does not appear to recognize the importance of the limitations present in the claims under rejection. For reasons set forth below, the claims pending in the present application patentably distinguish over Hecht.

For example, claim 43 requires the sensing wand to record information electronically from position information. The last paragraph of this claim required the sensing wand to initiate the predetermined operation for the recorded information in response to the detection of said at least one activation icon on the product. In other words, the claim requires the activation icon to initiate a predetermined operation for the recorded information obtained by the sensing wand from position information obtained from the position coding pattern. While Hecht may suggest initiating a predetermined operation, Hecht does not in any way suggest the initiation of a predetermined operation utilizing information recorded or obtained from the position coding pattern by the sensing wand. Thus, Hecht can not anticipate claim 43.<sup>3</sup>

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<sup>3</sup> It should be noted, contrary to the Examiner's assertion, claim 43 is not a method claim. It is presumed that the Examiner refers to claim 45 in the second full paragraph 5 of the Office Action.

Once again, with respect to claim 45, the activation icon, when detected by the wand, causes the wand to carry out a predetermined operation for the recorded information. Hecht did not teach this use of an activation icon to enable a predetermined operation that makes use of information written onto a writing surface and recorded by the wand.

With respect to independent claim 1, this claim is directed to a product related to the system of claim 43 and the method of claim 45. With respect to claim 1, once again, the activation code according to the limitations of this claim must cause the device to initiate a predetermined operation which utilizes the information recorded by the device from the writing position code region. This is not suggested by the Hecht reference. Further, the Hecht reference does not suggest the use of a writing position code region to enable electronic recoding of information as being written on the writing position code region as recited in claim 1. While it is true that the wand in Hecht may sense position, there is no evidence that this detected position is used by Hecht in the predetermined operation represented by an activation icon.

Independent claim 20 clearly requires the processing circuit to produce a signal to initiate a predetermined operation which utilizes the path information in response to identification of the activation icon. Once again, the Examiner's rejection does not make a *prima facie* case that this limitation of claim 20 is anticipated by the Hecht reference. Indeed, Hecht does not appear to read movement of the pen and then produce a signal to initiate a predetermined operation to utilize the pen path information by actuation of an activation icon. Consequently, this claim is also distinguishable from the Hecht reference.

The Examiner goes on to add the Lazzouni patent to Hecht to reject claims 4-8, 15-19, 27, 31, 33-37, 39, and 47-54. The Lazzouni reference does disclose a pen and paper information recording system which uses position indicia to track pen path. However, the Examiner fails to provide motivation to make the asserted combination, principally because the Examiner apparently fails to recognize the importance of this combination, that is that the predetermined operation enabled by the activation icon utilize the pen path information in the operation enabled thereby. In effect, the Examiner's rejection recognizes the deficiency of the Examiner's rejection combination by merely acknowledging that each reference performs a separate function. It is the interaction of these two functions that is recited in the claims of the present application and which provides a clear distinction over the Examiner's inappropriate rejection combination.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion of motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art to modify the references or to combine reference teachings; (2) there must be a reasonable expectation success; and (3) the prior art reference must teach or suggest all the claimed limitations. See *In re Vaeck*, 947 F.2d 48, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner states that it would be obvious to combine the functions of the two references so that a user can perform two functions. However, the references fail to recognize the desirability of employing activation icons to initiate a predetermined operation for using the pen path or written information. The Examiner can point to no motivation for the combination, because, stated simply, none exists.

Recent Federal Circuit decisions make it clear that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority, but must be supported by the objective evidence of the record. No such objective evidence exists in the instant matter. The burden placed on the Examiner to establish objective factual findings of record is addressed in the recent Federal Circuit decision *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002) *In re Lee* involved an appeal of a decision of the Board of Patent Appeals in which Lee argued that the Examiner failed to provide a source of teaching, suggestion or motivation to combine the applied prior art to arrive at the claimed invention. The Board responded to these arguments by ruling that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *Id.* at 1432. The Federal Circuit overturned the Board's decision "for failure to meet the adjudicated standards for review under the Administrative Procedures Act." *Id.* at 1431. The Federal Circuit further stated that "the factual inquiry whether to combine references must be thorough and searching...it must be based on objective evidence of record...[T]his precedent has been reinforced in a myriad of decisions and cannot be dispensed with." *Id.* at 1433.

Absent factual support for a teaching, suggestion, or motivation to combine the references, such a combination constitutes legal error. Consequently, unless the Examiner can identify some specific motivation to support the alleged combination which creates the claimed combination, the rejection combination is clearly in error.

For all of the above-stated reasons, the Examiner is respectfully requested to reconsider and to withdraw all outstanding rejections based on Hecht with or without Lazzouni and to pass to issue all claims of the present application.

Should there be any outstanding issues in the present application, the Examiner is invited to contact the undersigned at (703) 205-1300 to discuss these matters.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully request a one-month extension of time in which to file this Reply. A check for \$110 is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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By 

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**3782-182P**  
Attachment  
MKM:lab:rk

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